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EXAMINER	
LEE, JINHEE J	

ART UNIT	PAPER NUMBER
2175	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/775,835	KIM, YONG JOO	
	Examiner	Art Unit	
	Jinhee J. Lee	2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Korea on 2/6/03. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6, 8-12 and 14 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended limitation of "extracting and **storing** the thumbnail image from a broadcasting stream while the broadcasting stream is stored" is new matter not previously disclosed.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6, 8-12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "extracting and storing the thumbnail image from a broadcasting stream while the broadcasting stream is stored "in line 3-4. This is confusing. Storing while storing confusing as well as extracting and storing while storing.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 5-6, 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Srinivasan et al. (20010023436).

Re claim 1, Srinivasan et al. discloses an editing apparatus (author/editor, see paragraph 0182 for example) using a thumbnail image, comprising:

an image processing means for processing a broadcasting stream and an image signal to permit the processed broadcasting stream and image signal to be displayed (authoring system for video data stream, see abstract for example);

a display means for displaying an image; a storing means for storing the broadcasting stream and the thumbnail image (see paragraph 0175 stored files for example); an image extracting means for extracting the thumbnail image from the

broadcasting stream (14, see figures 1 and 15 for example) while the broadcasting stream is stored (see paragraph 0175, stored files manipulated according to edit for example); and

a control means for allowing a plurality of thumbnail images displayed on the display means according to a user's control command and thereby allowing the broadcasting stream represented by the thumbnail image to be edited (see paragraph 0182 and figure 15 for example).

Re claim 5, Srinivasan et al. discloses an editing apparatus, wherein the editing of the broadcasting stream is performed by deleting, storing and moving the thumbnail image (see paragraph 0182 for example).

Re claim 6, Srinivasan et al. discloses an editing method using a thumbnail image, the method comprising:

extracting and storing the thumbnail image from a broadcasting stream (see paragraph 0175 for example) while the broadcasting stream is stored (see paragraph 0175, stored files manipulated according to edit for example);

displaying a plurality of thumbnail images in response to a user's request (see figure 15 for example);

editing the plurality of thumbnail images (see figures 15 and paragraph 182 for example); and

wherein a section of the broadcasting stream is represented by the plurality of thumbnail images (see figure 15 and paragraph 0182 for example).

Re claim 11, Srinivasan et al. discloses an editing method, wherein the editing of the thumbnail image is performed by a method deleting, moving and separately storing a portion of the plurality of thumbnail images (see paragraph 0182 for example).

Re claim 12, Srinivasan et al. discloses an editing method, wherein the editing of the broadcasting stream is performed concurrently with the editing of the thumbnail image (see paragraph 0175 for example).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 2-4, 8-10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al. in view of Drucker et al. (7251790).

Re claim 2, Srinivasan et al. substantially discloses an editing apparatus as set forth in claim 1 above. Srinivasan et al. does not explicitly disclose wherein the thumbnail image is extracted at a predetermined time interval. However, Drucker et al. teaches of wherein the thumbnail image is extracted at a predetermined time interval. (see column 4 line 47 according to the numbering in the middle for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein the thumbnail image is extracted at a predetermined time interval of Drucker et al. on an editing apparatus of Srinivasan et al. in order to facilitate media browsing.

Re claim 3, Srinivasan et al. substantially discloses an editing apparatus as set forth in claim 1 above. Srinivasan et al. does not explicitly disclose wherein the thumbnail image is extracted at each scene change point. However, Drucker et al. teaches of wherein the thumbnail image is extracted at each scene change point (see column 4 line 48 according to the numbering in the middle for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein the thumbnail image is extracted at each scene change point of Drucker et al. on an editing apparatus of Srinivasan et al. in order to facilitate media browsing.

Re claim 4, Srinivasan et al. substantially discloses an editing apparatus as set forth in claim 1 above. Srinivasan et al. does not explicitly disclose wherein the thumbnail image is extracted by using histogram information on each frame of the broadcasting stream. However, Drucker et al. teaches of wherein the thumbnail image is extracted by using scene change point, and the contents can be analyzed using the scene change point or shot boundary based on histogram information on each frame of the broadcasting stream (see column 6 lines 34-37 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein the thumbnail image is extracted by using histogram information on each frame of the broadcasting stream of Drucker et al. on an editing apparatus of Srinivasan et al. in order to facilitate media browsing.

Re claim 8, Srinivasan et al. substantially discloses an editing method as set forth in claim 6 above. Srinivasan et al. does not explicitly disclose wherein the

thumbnail image is extracted at a predetermined time interval. However, Drucker et al. teaches of wherein the thumbnail image is extracted at a predetermined time interval(see column 4 line 47 according to the numbering in the middle for example. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein the thumbnail image is extracted at a predetermined time interval of Drucker et al. on an editing method of Srinivasan et al. in order to facilitate media browsing.

Re claim 9, Srinivasan et al. substantially discloses an editing method as set forth in claim 6 above. Srinivasan et al. does not explicitly disclose wherein the thumbnail image is extracted by using histogram information on each frame of the broadcasting stream. However, Drucker et al. teaches of wherein the thumbnail image is extracted by using scene change point, and the contents can be analyzed using the scene change point or shot boundary based on histogram information on each frame of the broadcasting stream (see column 6 lines 34-37 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein the thumbnail image is extracted by using histogram information on each frame of the broadcasting stream of Drucker et al. on an editing method of Srinivasan et al. in order to facilitate media browsing.

Re claim 10, Srinivasan et al. substantially discloses an editing method as set forth in claim 6 above. Srinivasan et al. does not explicitly disclose wherein the thumbnail image is extracted at each scene change point. However, Drucker et al. teaches of wherein the thumbnail image is extracted at each scene change point (see

column 4 line 48 according to the numbering in the middle for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein the thumbnail image is extracted at each scene change point of Drucker et al. on an editing method of Srinivasan et al. in order to facilitate media browsing.

Re claim 13, the system of Srinivasan et al./Drucker et al. discloses the claimed invention except wherein the predetermined time interval is set by the user. It would have been an obvious matter of design choice to have wherein the predetermined time interval is set by the user, since such a modification would have involved the mere application of a known technique (allowing the user to set certain criteria such as time interval) to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 14, the method of Srinivasan et al./Drucker et al. discloses the claimed invention except wherein the predetermined time interval is set by the user. It would have been an obvious matter of design choice to have wherein the predetermined time interval is set by the user, since such a modification would have involved the mere application of a known technique (allowing the user to set certain criteria such as time interval) to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Response to Arguments

10. Applicant's arguments filed 4/23/08 have been fully considered but they are not persuasive.

In response to applicant's arguments that Srinivasan does not teach “extracting the thumbnail image of the broadcasting stream while the broadcasting stream is

stored", examiner disagrees. In order to sort and manipulate thumbnails, they have to be extracted, it is untrue that the art of Srinivasan does not suggest extracting. Further, in paragraph 0175, it states that the thumbnails are linked to the stored digital files that were created, and that an editing file could alternatively be created, i.e. stored in a separate file. Therefore, Srinivasan meets the claim requirements.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Srinivasan et al. and Drucker et al. teaches of using, editing or manipulating thumbnail images of datas.

Also note that the examination includes giving each term in the claim its broadest reasonable interpretation in determining patentability of the claim.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-2100 ext. 75. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jinhee J Lee/
Primary Examiner, Art Unit 2174

jjl